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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/801,327	02/18/97	MULLER	B 1-20161/A/CO
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EXAMINER

EINSMANN, M

ART UNIT

PAPER NUMBER

1751

DATE MAILED:

09/24/99

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SEP 27 1999

ANDREA DECECCHIS
DOCKET COORDINATOR
PATENT DEPARTMENT

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

(FR)

Office Action SummaryApplication No.
08/801,327Applicant(s)
MullerExaminer
Margaret EinsmannGroup Art Unit
1751**RECEIVED**☒ Responsive to communication(s) filed on Aug 23, 1999**SEP 27 1999**☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to this matter is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213. **ANDREA D. FISCHER**
DOCKET COORDINATOR
PATENT DEPARTMENT

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 2, 3, 5-12, and 16-19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 11 and 12 is/are allowed.☒ Claim(s) 2, 3, 5-10, and 16-19 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been☒ received.☐ received in Application No. (Series Code/Serial Number) _____.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152**DOCKETED****FOR:**Nov. 24, 1999(FR)1-201611A/CONT/CPAY

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

Continued Prosecution Application

1. The request filed on August 23, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/801,327 is acceptable and a CPA has been established. An action on the CPA follows.

The preliminary amendment filed with the CPA has been entered into the file. The pending claims are 2-3, 5-12,16-19.

Claims 11 and 12 are allowed.

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same

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Closely related homologs, analogs and isomers in chemistry may create a prima facie case of obviousness. *In re Dillon* USPQ 2d 1897, 1904 (Fed. Cir. 1990); *In re Payne* 203 USPQ 245 (CCPA 1979); *In re Mills* 126 USPQ 513 (CCPA 1960); *In re Henze* 85 USPQ 261 (CCPA 1950); *In re Hass* 60 USPQ 544 (CCPA 1944). The abstract discloses the utility for dyeing hydroxyl and nitrogen containing fiber materials.

This rejection is maintained as applied in the office actions of 03/05/96 and 11/19/96 in the parent application 08/541,009 for the reasons which follow.

4. Applicants have responded to this rejection by presenting a declaration by Dr. Bernhard Muller. The declaration under 37 CFR 1.132 filed 8/29/96 is insufficient to overcome the rejection of all the claims at issue based upon the insufficiency of the comparisons presented. Said declaration compares dyestuff 78 of GB-A-2,034,731, wherein B₁ is a three carbon alkyl component to applicants' claimed dyestuff where B₁ is a five carbon alkyl. Applicants claim three variations of B₁ which are five or six carbon isomers and one which is a three carbon alkyl chain substituted by a hydroxyl group. If applicants were to compare dye 78 of GB-A-2,034,731 with applicants' claimed B₁ component which is a three carbon chain substituted by hydroxyl and show unexpected results, that would be deemed to be a comparison of

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person or subject to an obligation of assignment to the same person.

3. Claims 2-3,5-10,16-19 are rejected under 35 U.S.C. § 103 as being unpatentable over Harms, GB 2,034,731.

Harms discloses water soluble reactive dyestuffs inclusive of applicant's dyestuff 1 when it contains the selected alkyl radicals as the B₁ aliphatic bridge member. Harms teaches that such bridge may be a straight or branch chain alkylene having 2-15 carbon atoms. See page 1 especially line 29 to page 2 line 5. Note that the preferred bridge member of applicant's claims 8,9 and 19 is specifically listed among the five carbon bridge member on line 35 of page 1.

Harms differs from formula 1 in failing to show a working example of the five carbon isomers as claimed herein for the B₁ component in the instantly claimed dyestuffs.

The subject matter would have been obvious to the skilled artisan absent a showing of criticality because it is clear from the examples of bridge members exemplified in the disclosure from page 1 lines 32 to page 2 that five carbon alkyl isomers are preferred embodimentss. Applicants' dyes containing isomers are disclosed on page 1 of Harms and are thus equivalent to the aliphatic bridge members of the working examples. Note that structurally similar compounds are generally expected to have similar properties. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552.

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the closest art to that particular claimed component. The five carbon isomers are clearly favored by Harms for the bridge member, being listed on page 1 line 33 -36 no less than four times. Examples 48 and 74 of Harms show five carbon alkyl groups exemplified as B₁. Each should have been compared to all of the five used as the B₁ component in applicants' presently claimed dyestuffs. Since said alkyl chains are clearly disclosed by Harms, comparisons of each of the bridge members for which a patent is solicited must be made to the closest isomers in Harms' examples. The five member isomers must be compared to five member isomers for it to be a true comparison of the closest art.

Applicant has provided a further declaration that shows that the 2-4 diamino pentane is not available and cannot be made by synthetic organic chemical procedures. Applicant argues that the mere naming of a compound in a reference without more cannot constitute a description of a compound, particularly when the evidence of record suggests that no method exists for its preparation. In response to this argument, this office states that the validity of a patent cannot be questioned.

Additionally, a reference must be read for the totality of what it teaches. All of the disclosures in a reference must be evaluated for what they fairly teach to one of ordinary skill in the art. In re Smith, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; In re Nehrenberg, CCPA 1159, 280 F. 2d 161, 126 USPQ 383. Harms

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clearly discloses the specific 2-dimethyl propyl bridge member which is applicant's preferred bridge member, as well as other five carbon isomers of pentane. Note the four specifically listed on page 1 lines 33-36. In addition to this, patentees teach literally in several places that isomers are equivalent to the bridge members used. See examples 37,43,44,59,61,88,89, 91,97. All disclosures of the prior art, including non-preferred embodiment, must be considered. See In re Lamberti and Konort, 192 USPQ 278 (CCPA 1967); In re Snow 176 USPQ 328 (CCPA 9173)

Claims 11-12 are allowable over the prior art of record.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory

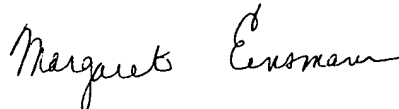
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period for response expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M.

The fax phone number for this Technology Sector is (703) 305-3599

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Sector receptionist whose telephone number is (703) 308-0661.



MARGARET EINSMANN
PRIMARY EXAMINER 1751

September 23, 1999